

REMARKS

Reconsideration and further examination of the subject patent application in light of the present Amendment and Remarks is respectfully requested. A Request for Continued Examination accompanies this Amendment and Reply.

Claim Objections

Claims 1-6, 8-26, 29-32, 34, 36-37, 39-42, 49, 73-75, 78, 82, 95, 97-100, 108-112, 121-126, 128, 134 and 141 are currently pending in the application. Claims 14-23, 34, 36, 41-42, 94-100, 108-112, 121-140, 141 are cancelled by the subject amendment. Claims 1-6, 8-26, 29-32, 34, 36-37, 39-42, 49, 73-75, 78, 82, 95, 97-99, 108-112, 121-126, 128, 134 and 141 stand rejected, and claim 100 stands objected to. Thus, the remaining pending claims are 1-6, 8-13, 24-26, 29-32, 37, 39, 40, 49, 73-75, 78, 82, and 142-143 (with claims 1, 24 and 73 being independent)

Rejection Under 35 U.S.C. §112

Pending claims 1, 14 (cancelled), 24, 73, and 94 (cancelled) stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants respectfully traverse this rejection.

The invention is directed to an adapter configured to attach to an associated anchor rail. The associated anchor rail is known and is not part of the novel features of the claimed invention. However, the claimed adapter is used in conjunction with the known anchor rail. The anchor rail is recited in the preamble because it is known and because it is needed to provide proper antecedent basis for various terms. Applicants know of no prohibition against reciting known structure in the preamble of a claim. In any event, to recite the claimed invention more positively, applicants have

amended the preamble of claims 1 and 24 to recite “for use with an anchor rail . . . an adapter comprising” Accordingly, applicants respectfully request that the rejection under §112 be withdrawn.

Double Patenting Rejection

Applicants submit herewith a terminal disclaimer. Accordingly, the claims rejected under §103 with respect to US Patent No. 6,354,543 (Paske) should be allowable.

Rejection Under 35 U.S.C. §102

The rejection of the claims under §102(f) should be overcome with the submission of the terminal disclaimer attached hereto. Claims 1, 2, 7-9, and 141 stand rejected under 102(b) as being anticipated by Kreinberg. Applicants respectfully traverse this rejection. Because claims 7 and 141 have been cancelled, applicants will only address claims 1, 2, and 8-9, and in particular, independent claim 1.

Several features of applicants’ claimed adapter is missing in Kreinberg. As a preliminary matter, it is important to understand the differences between applicants’ claimed adapter, and the conduit holder depicted in Kreinberg. The conduit holder in Kreinberg is intended to support cables or other conduit on a support having an aperture, which aperture is typically circular. The Kreinberg conduit holder is a “stand-alone” device meant to bolt to a support surface and support a conduit.

In contrast, applicants’ claimed adapter makes it possible to use line hangers (52) of the type shown in Figs. 2-3 of the specification, and notably, the hangers of the type shown in Paske U.S. Pat. No. 6,354,543, which patent is the subject of the attached terminal disclaimer. In one embodiment shown in Fig. 1, the claimed adapter has a hanger-receiving portion with an opening (26), which can be engaged by the barbs (54 of Fig. 2) on the legs of the hanger 52.

Applicants are claiming the adapter, not the “associated article support hanger nor the U-shaped channel. It is the Kreinberg reference that is directed to the conduit holder itself. As shown in Fig. 6 of Kreinberg, a screw or bolt 58 attaches the Kreinberg holder to a panel or wall 92. The Kreinberg conduit holder is incapable of supporting lines on U-shaped channels of the type illustrated in Fig. 1 of applicants’ invention. In that regard, the Kreinberg conduit holder is completely missing the claimed element of “mounting legs extending from the flanges, the mounting legs each having a hook-like portion for engaging the corresponding rail lip, the hook-like portion extending substantially along a width of the mounting leg...” Further, the Kreinberg conduit holder is completely missing the claimed element of the “adapter being flexible to permit urging of the flanges inwardly toward each another to facilitate insertion of a portion of the mounting legs into the U-shaped channel, the adapter further being resilient such that the hook-like portions biasingly engage the rail lips.”

Because significant elements of applicants’ claimed invention is missing from the conduit holder in Kreinberg, the Kreinberg reference cannot anticipate applicants’ claimed invention. Accordingly, applicants assert that independent claim 1 is allowable over Kreinberg. Further, applicants assert that claims 2 and 8-9 are also allowable as depending from allowable base claim 1.

Applicants respectfully note that anticipation focuses on whether a claim reads on the product or process that a prior art reference discloses, not on what the reference broadly “teaches.” Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). As the Examiner is aware, each and every element of a claim must be shown in the “four corners” of the reference. “To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter.” PPG Industries v. Guardian Industries, 75

F.3d 1558, 37 U.S.P.Q.2d 1618 (Fed. Cir. 1996).

Rejection Under 35 U.S.C. §103

Most of the rejection of the claims under §103 should be overcome with the submission of the terminal disclaimer attached hereto. Claims 11, 12, 18, 19, 30, 31, 98, 99 and 110-112 stand rejected under 103(a) as being unpatentable over Paske and Heath. Because claims 18, 19, 98, 99 and 110-112 have been cancelled and the primary reference to Paske should be removed by the submission of the terminal disclaimer, applicants will only address claims 11, 12, 30, and 31 with respect to the secondary reference to Heath standing alone. Applicants will address this rejection by reference to the independent base claims, namely claims 1 and 24.

Because Heath now stands alone without support from the primary reference to Paske, applicants submit that it is clear that Heath does not teach or suggest applicants claimed invention. Applicants reassert the arguments above with respect to §102 and the differences between applicants' claimed invention and reference devices that are directed merely to conduit holders or clips. Accordingly, applicants submit that the claimed invention is not unpatentable over Heath.

Claims 11 and 12 stand rejected under 103(a) as being unpatentable over Kreinberg in view of Heath. Again, applicants reassert the arguments above with respect to §102 and the differences between applicants' claimed invention and reference devices that are directed merely to conduit holders or clips. The clip in Heath is very similar to the conduit holder in Kreinberg, although Kreinberg is a more sophisticated and complex design. The end result is that each of the reference devices merely hold some type of cable, and each of the devices are configured to be affixed to a support. In Kreinberg, the screw or bolt 58 attaches the conduit holder, while in Heath, the lugs 5 are inserted into an aperture.

Neither reference, taken alone or together, teach or suggest applicants' claimed adapter. The concept of the adapter is completely missing in Kreinberg and/or Heath. Moreover, there would be no reason for either of the references to address an adapter of applicants' claimed design because those references are directed to the holder or clip itself, not to an adapter that permits a known hanger to be attached to a known U-shaped anchor rail. Accordingly, applicants assert that the claimed invention is not unpatentable over Kreinberg in view of Heath.

Claim 13 stands rejected under 103(a) as being unpatentable over Kreinberg in view of Andre. Again, applicants reassert the arguments above with respect to §102 and the differences between applicants' claimed invention and reference devices, and further reasserts the arguments above with respect to §103. Andre is cumulative and adds nothing to the art. It is merely another holder or clamp. Accordingly, applicants assert that the claimed invention is not unpatentable over Kreinberg in view of Andre.

Claim 32 stands rejected under 103(a) as being unpatentable over Paske in view of Andre. Because the primary reference to Paske should be removed by the submission of the terminal disclaimer, applicants need only address claim 32 with respect to the secondary reference to Andre standing alone. Again, reasserting the above arguments, applicants submit that it is clear without further elaboration that the simple cable clamp in Andre does not teach or suggest applicants claimed invention.


For the foregoing reasons, applicants submit that the subject application is in condition for allowance and earnestly solicits an early Notice of Allowance. Should the Examiner be of the opinion that a telephone conference would expedite prosecution of the subject application, the Examiner is respectfully requested to call the undersigned at the below-listed number.

The Commissioner is hereby authorized to charge any additional fee which may be required for this application under 37 C.F.R. §§ 1.16-1.18, including but not limited to the issue fee, or credit any overpayment, to Deposit Account No. 23-0920. Should no proper amount be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 23-0920. A duplicate copy of this sheet(s) is enclosed.

Respectfully submitted,

WELSH & KATZ, LTD.

By


Eric D. Cohen
Registration No. 38,110

WELSH & KATZ, LTD.
120 South Riverside Plaza
22nd Floor
Chicago, Illinois 60606
(312) 655-1500
March 11, 2004